

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Our Ref: 1038-729 MIS:ja

In re patent application

No.

08/931,721

Applicant:

Barbara Papadopoulou et al

Title:

MACROPHAGE-INFECTING PARASITES
EXPRESSING A GRANULOCYTE MACROPHAGE
COLONY STIMULATING FACTOR

Filed:

September 16, 1997

Group No.

1647

RECEIVED

Examiner:

R. Haynes

OCT 03 2000

September 28, 2000

OFFICE OF PETITIONS

RESPONSE TO NOTIFICATION OF NON-COMPLIANCE WITH 37 CFR 1.192(c)

BY COURIER

The Commissioner of Patents
and Trademarks,
BOX AF,
Washington, D.C. 20231,
U.S.A.

Dear Sir:

In response to the Office Communication dated July 19, 2000 and the Notification of Non-Compliance with 37 CFR 1.192, the following observations are made:

1. The Examiner indicated that at least one Amendment has been filed subsequent to the Final Rejection and the Appeal Brief does not contain a statement of the status of each such Amendment. It is submitted that such is incorrect. Paragraph 6 of the Appeal Brief clearly identifies the submission of an Amendment after Final Action simultaneously with the Appeal Brief. It is only upon receipt of the Advisory Action also appended to the Office Communication of July 19,

2000 that the status of the Amendment was known. Nevertheless, submitted herewith is an Amended Appeal Brief in triplicate wherein the status of the Amendment after Final Action, is described.

2. The Examiner indicates that a single ground of rejection has been applied to two or more claims in the application, and the Appeal Brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together and yet the Appeal Brief does not present arguments in support thereof in the arguments section of the Appeal Brief. It is submitted that such is not correct . In the discussion of the rejection of claims 1, 3 to 6 and 21 on the basis of Moore et al and Wong et al, there is specific discussion of the separate patentability of claim 4 in the absence of a teaching in the cited prior art of a further modified form of the *Leishmania* parasite (page 6 of Appeal Brief and Amended Appeal Brief). Since the rejection of claims 1, 3 to 7 and 21 under 35 USC 103(a) on the basis of Moore et al in view of Wong et al in view of Laban et al adds Laban et al with respect to the feature of claim 7, the independent patentability of claim 4 over this combination also is urged, the remarks with respect to the combination of Moore et al with Wong et al being incorporated by reference and "requires no further elaboration" (see page 6, Appeal Brief and Amended Appeal Brief).
3. The Examiner indicated that the Appeal Brief does not contain a correct copy of the appended claims as an Appendix thereto. The claims listed in the Appendix to the Appeal Brief have been reviewed and it is not seen in what respect that the claims are incorrect. The claims do include claim 10 in the form set prior to entry of the Amendment after Final Action (i.e. as they stood at the time of filing the Appeal Brief) and perhaps this is the difficulty that the Examiner has with the claims. Appended to the Amended Appeal Brief is an Appendix containing the claims now appealed, which now do not include claim 10, which has been allowed according to the Advisory Action.

4. Since the Assignment referred to in Paragraph 3 of the Appeal Brief of April 26, 2000 now has been recorded, the recordal particulars are included in the Amended Appeal Brief.

Having regard to the above, it is submitted that the Amended Appeal Brief complies with 37 CFR 1.192(c).

Respectfully submitted,


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